

**SRI v. ISS and Symantec**

**Exhibit 5 to the Proposed Pretrial Order**

**SRI'S STATEMENT OF ISSUES OF LAW**  
**REMAINING TO BE LITIGATED L.R. 16.4(d)(5)**

SRI expects it will present or rebut the below listed issues of law at trial. To the extent that any issues of fact set forth in Exhibit 2 of the Joint Pretrial Order may be considered issues of law, SRI incorporates those portions of Exhibit 2 by reference. These issues of law may change based on the Court's decisions on claim construction, motions for summary judgment, and motions *in limine*.

**A. Validity of SRI's Patents**

1. SRI will present evidence in rebuttal to defendants' assertions that each of: (a) claims 1, 2, 4, 6, 12, 13, 15, 17 of the '203 patent and claims 1, 2, 4, 13, 14, 16 of the '615 patent; (b) as also alleged by ISS, claims 1, 4, 5, 11, 12, 13, 24 of the '338 patent; and (c) as also alleged by Symantec, claims 1-6, 14-17 of the '212 patent and claim 7 of the '615 patent is invalid under 35 U.S.C. § 103 as obvious in light of the prior art.

Authority:

- *Graham v. John Deere Co.*, 383 US. 1 (1966).
- *Alza Corp. v. Mylan Laboratories, Inc.*, 391 F.3d 1365, 1373 (Fed. Cir. 2004).
- *Glaxo Group Ltd. v. Apotex, Inc.*, 376 F.3d 1339 (Fed. Cir. 2004).
- *Honeywell Intern. Inc. v. Hamilton Sundstrand Corp.*, 370 F.3d 1131 (Fed. Cir. 2004).
- 35 U.S.C. § 103
- 35 U.S.C. § 282

3. SRI will present evidence in rebuttal to defendants' assertions that each of: (a) claims 1, 2, 4, 6, 12, 13, 15, 17 of the '203 patent and claims 1, 2, 4, 13, 14, 16 of the '615 patent; (b) as also alleged by ISS, claims 1, 4, 5, 11, 12, 13, 24 of the '338 patent;

and (c) as also alleged by Symantec, claims 1-6, 14-17 of the '212 patent and claim 7 of the '615 patent are invalid as not enabled.

Authority:

- 35 U.S.C. § 112.
- *Invitrogen Corp. v. Clontech Laboratories, Inc.*, 429 F.3d 1052, 1071 (Fed. Cir. 2005).
- *BJ Services Co. v. Halliburton Energy Services, Inc.*, 338 F.3d 1368, \*1373 (Fed. Cir. 2003).
- *Moba, B.V. v. Diamond Automation, Inc.*, 325 F.3d 1306, 1321 (Fed. Cir. 2003).

5. SRI will present evidence in rebuttal to defendants' assertions that allegedly anticipatory prior art is enabled.

Authority:

- *Amgen Inc. v. Hoechst Marion Roussel, Inc.*, 457 F.3d 1293, 1306-1307 (Fed. Cir. 2006).
- *Elan Pharmaceuticals, Inc. v. Mayo Foundation for Medical Educ. and Research*, 346 F.3d 1051, 1057 (Fed. Cir.2003) (en banc).

**B. Non-Jury Issues for Court**

1. Whether clear and convincing evidence shows that the named inventors or others involved in the prosecution of the patents-in-suit failed to disclose material information with an intent to mislead the United States Patent and Trademark Office, thereby rendering the patents-in-suit unenforceable.

Authority:

- *Monon Corp. v. Stoughton Trailers, Inc.*, 239 F.3d 1253, 1264 (Fed. Cir. 2001).
- *Union Oil Co. of California v. Atlantic Richfield Co.*, 208 F.3d 989, 1002 (Fed. Cir. 2000).